

Appln. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

REMARKS

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

Claims 1, 2, 4 through 24, 26, 28 and 30 through 34 remain in this application. Claims 3, 25, 27 and 29 have been cancelled. No claims have been withdrawn. No claims have been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 3 of the Office Action

Claims 1, 2, 4 through 24, 26, 28 and 30 through 34 have been rejected under 35 U.S.C. §112 (first paragraph) as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

It is again contended in the Office Action that:

Claims 1-2, 4-24, 26, 28, 30 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Currently amended independent claims 1, 9 and 17 recite the limitation, "said description of a function being dependent upon particular capabilities of the combination of said at least two system elements of said included in said system configuration selection". There does not appear to be a written description of this claim limitation. The originally filed disclosure, see Figs. 5A and 5B and paragraph 0018 of the PG-PUB 2002/0188519 A1 of the applicant's application that the description of the functions provided to the user who is configuring the selection include a description of a function capable of being implemented by each component and the disclosure does not teach describing a function being dependent upon particular

Page 9 of 29

Appln. No. 09/876,577

Amendment dated March 28, 2007

Reply to Office Action mailed November 28, 2006

capabilities of the combination of said at least two system elements of said included in said system configuration selection. Since claims 2, 4-8, 10-16, 18-24, 26, 28, 30 and 33 are dependencies of claims 1, 9 and 17 they also inherit the same deficiency.

However, turning to the disclosure of the application at ¶ 0018, it is stated that (emphasis added):

[0018] The browsing interface of the present invention may receive a system configuration selection based on a combination of system elements selected from the list of configuration choices 230. It is understood that a system configuration selection based on a combination of system elements may include but is not limited to a selection of a single component or a group of components without departing from the scope and spirit of the present invention. The relational database of the present invention may analyze the system configuration selection and provide a description of a function capable of being implemented with the system configuration selection 240. The information presented may include a description of a function capable of being implemented by each component.

It is submitted that one of ordinary skill in the art, considering the explicit disclosure in paragraph [0018] that “a system configuration selection based on a combination of system elements may include but is not limited to a selection of a single component or a group of components” discloses that the configuration selection may include 1) a single component or 2) a group of components (e.g., “at least two system elements”). Paragraph [0018] also explicitly states that “the present invention may analyze the system configuration selection and provide a description of a function capable of being implemented with the system configuration selection”, and one of ordinary skill in the art would recognize that the requirement of “said description of a function being dependent upon particular capabilities of the combination of said at least two system elements included in said system configuration selection” is disclosed in the present application as filed. While the word “particular” is not specifically used in the present disclosure, it is submitted that one of ordinary skill in the art, considering the entire disclosure of the present patent application, would recognize that the function is dependent upon the system configuration of a combination of

Appl. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

system elements including a group of components.

It appears that since paragraph [0018] states that "[t]he information presented *may include* a description of a function capable of being implemented by each component" (emphasis added), the Patent Office does not give proper weight to the statement in paragraph [0018] that the system may "provide a description of a function capable of being implemented *with the system configuration selection*", where it is made clear earlier in paragraph [0018] that "[i]t is understood that a system configuration selection based on a *combination of system elements* may include but is not limited to a selection of a single component *or a group of components*".

However, paragraph [0018] is not the only mention of this in the applicant's disclosure--see, for example, paragraph [0023] of the present application, which states (emphasis added):

[0023] Referring now to FIGS. 5A and 5B, alternative embodiments of displays of the browsing interface of the present invention is shown. Referring specifically to FIG. 5A, a lower end model of a printer and a lower end model of a digital camera have been selected in the purchase of a build-to-order computer system. Based upon the user's selections of a lower end model of a printer and a lower end model of a digital camera, a window presenting information regarding the functionality of the system is presented. In FIG. 5B, a higher end model of a printer and a higher end model of a digital camera has been selected by a user. The browsing interface of the present invention may provide a description of the function capable of being implemented with the higher end selections. The content presented by the browsing interface of the present invention may inform the user regarding the advantages of a particular system configuration in order to allow the user to acquire a system that meets his or her needs.

Again, the statements here are consistent with the interpretation set forth above that the information provided by the system regards the combination of elements or components, and not a single element.

It is therefore submitted that the disclosure of the patent application does establish that the inventor had possession of the claimed invention.

Appln. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

Withdrawal of the §112 (first paragraph) rejection of claims 1, 2, 4 through 24, 26, 28 and 30 through 34 is respectfully requested.

Paragraphs 4 and 5 of the Office Action

Claims 1, 2, 8 through 11, 16 through 19, 24 and 31 through 34 have been rejected under 35 U.S.C. §102(e) as being anticipated by Henson.

Claims 4, 12 and 20 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Henson.

Claims 5 through 7, 13 through 15 and 21 through 23 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Henson in view of Tuzhilin.

Claims 26, 28 and 30 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Henson in view of Tuzhilin and further in view of Roberts

It is stated in the Response to Arguments portion of the most recent Office Action that:

MPEP guidelines 2111 [R-5] Claim Interpretation, direct that the pending claims, during patent examination, must be "given their broadest reasonable interpretation consistent with the specification." >The Federal Circuit's en banc decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard. The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art.' In re Am. Acad. of Sci. Tech. Or., 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Accordingly, as analyzed above in paragraph 2.1 above, the examiner gives the claim limitation "said description of a function being dependent upon particular capabilities of the combination of said at least two system elements of said included in said system configuration selection" broadest reasonable interpretation consistent with the specification as— providing said description of a function being dependent upon

Appln. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

capabilities of each component/system element of the combination—and this is fairly suggested by Henson as already analyzed in previous office action mailed on 3/6/2006, see pages 2-4 under "response to Arguments" and pages 7-10. Therefore, the rejection of independent claims 1,9,17 and 31 as being anticipated by Henson is sustainable and maintained.

Thus, the logic of the rejection of the Office Action is based upon the "interpretation" that "providing said description of a function being dependent upon capabilities of each component/system element of the combination" is a reasonable interpretation of "said description of a function being dependent upon particular capabilities of the combination of said at least two system elements of said included in said system configuration selection". Thus, this interpretation of the language of claim 1 literally and explicitly ignores the inclusion of the limitation "of the combination of said at least two elements" in claim 1. It is submitted that the language of the MPEP does not allow the Patent Office to simply ignore the explicit terms of the claim, and thus allow "capabilities of the combination [of elements]" become "capabilities of each [element]" as set forth in the Office Action. The most striking point here is the substitution of "each" in the interpretation for the word "combination" in the claim. It is submitted that the rephrasing of the language of the claim is not consistent with the MPEP. For example, MPEP §2111 states:

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)

Nothing in the rejection of the Office Action sets forth why one of ordinary skill in the art would understand that "capabilities of each [element]" is consistent with "capabilities of the combination [of elements]" as interpreted in the rejection. The Office Action does not establish that the "broadest reasonable interpretation" of "combination" (as stated in the claim language) includes "each" (as stated in the rejection), as these terms

Appln. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

have almost opposite meanings to one of ordinary skill in the art, one meaning "collectively" and the other meaning "individually".

Further, MPEP 2111.01 further states (underline emphasis added):

THE WORDS OF A CLAIM MUST BE GIVEN THEIR "PLAIN MEANING" UNLESS SUCH MEANING IS INCONSISTENT WITH< THE SPECIFICATION

****>Although<** claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004) (The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation >in light of the specification<.). This means that the words of the claim must be given their plain meaning unless **>the plain meaning is inconsistent with< the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. Thus, "heating the resulting batter-coated dough to a temperature in the range of about 400°F to 850°F" required heating the dough, rather than the air inside an oven, to the specified temperature.). **

It is submitted that the "plain meaning" of "combination" does not include "each", and thus the broadest reasonable interpretation" of "combination" does not include "each". It is therefore submitted that the interpretation being applied to the claims language in making the rejections of the claims over Henson (alone and in combination with the secondary patents) is not the "broadest reasonable" interpretation permitted by the U.S.P.T.O. rules.

As previously noted, claim 1 requires, in part, "providing a description of a function capable of being implemented with the combination of at least two system elements of said system configuration

Appln. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

selection, said description of a function being dependent upon particular capabilities of the combination of said at least two system elements included in said system configuration selection". Claim 9 requires "receiving a system configuration selection including a combination of at least two system elements of said available system elements selected from said list of configuration choices, said system configuration selection including a group of elements" and "providing a description of a function capable of being implemented with said system configuration selection including the group of components, said description of a function being dependent upon the combination of said at least two system elements included in said system configuration selection". Claim 17 requires "means for providing a description of a function capable of being implemented with the combination of at least two system elements of said system configuration selection, said description of a function being dependent upon particular capabilities of the combination of said at least two system elements included in said system configuration selection". Claim 31 requires "providing a description of a function capable of being implemented with the particular combination of said at least two system elements comprising said system configuration selection" and "upon receiving an updated system configuration selection, providing an updated and different description of a function capable of being implemented with said updated system configuration selection".

Turning first to the "Response to Arguments" portion of the most recent Office Action, it is stated there that:

The examiner respectfully disagrees [with applicant's argument that Henson does not teach the quoted requirement of claim 1] because Henson does suggest the above recited limitation: Applicant's attention is drawn to Figs. 3A and 3B which disclose configuring a computer system made of selection of several system elements, such as Dell SPS R MiniTower, Monitor, Printers, and Scanners and providing a description of function capable of being implemented with the combination of at least two systems, that is providing function of Dell MiniTower as to deliver tremendous speed to high end applications, for Printers for being capable to print the kid's

Appln. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

artwork or output professional quality documents and for scanners to *be* able to turn hardcopies of photographs and graphics into digital files, etc.

In this portion of the arguments, it is noted that the examples given are each directed to a function provided by *one* component of the total configured system, and not by any combination of the components. More specifically, the example of "Printers for being capable to print the kid's artwork or output professional quality documents" and "scanners to *be* able to turn hardcopies of photographs and graphics into digital files, etc". In each of these examples given in the Office Action, the statement associated with each of the components is directed solely to the function of that component, and it is noted that any printer is "capable to print the kid's artwork", and any scanner is capable of "turn[ing] hardcopies of photographs and graphics into digital files", so other than describing the basic function of each of these components, there is no description of any function provided by a "particular combination of said at least two system elements comprising said system configuration selection". Perhaps more importantly, the statement in the figures of regarding the "Dell MiniTower" is a very general and vague statement as to the overall function of the system, that (as previously pointed out) does not change no matter what the various components are selected by the customer for the system configuration on the page. Thus, if this broad statement of function is not changed as the components of the configuration are changed, it cannot be said that this broad statement reflects any function of a "particular combination of said at least two system elements" as required by claim 1. In fact, the disclosure of Henson refers to the matter regarding the "Dell Dimension XPS R" at reference number "79" as "merchandising messaging", which is distinguished from "option recommendations 75". Clearly, the statement at reference number 79 regarding the "Dell Dimension XPS R" is advertising fluff that could be said about *any* computer having *any* processor, regardless of what components might be combined with the processor.

Appln. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

Further, it is stated in the "Response to Arguments" section that:

This is in line with the applicant's invention as disclosed in Fig. 5 A and page 5, lines 13-16 which show selecting two system elements as a printer and a camera and displaying the description of function of each element, that the capabilities of the printer and camera separately for the combined system including printer and camera.

This attention to the disclosure of the applicant's application, and not the claims themselves, is believed to be misdirected as it is the claims that define the invention, but they will be addressed in the belief that it might facilitate greater understanding of the claimed invention, and not just the disclosure. Turning to Figure 5A (and similarly Figure 5B) of the applicant's disclosure, it is noted that selections (or non-selections) for the various components of the system are shown in a number of dropdown menu-type windows. Further, an overlying window is shown in Figure 5A that sets forth capabilities of the combination of *at least two system elements of the system configuration*. While some of the capabilities of the system do naturally depend upon the characteristics of the individual component selections for the system, it is submitted that the capabilities of the system displayed in the overlying window are not all directed to the characteristics of one particular component of the configuration, but of the functions of the system configuration with the combination of at least two system elements. More specifically, the characteristic "[t]ake good quality pictures to email to friends" has no relationship to the "printer" selection for the system configuration shown on the webpage, and the characteristic "[p]color images at 1 page per minute" has no relationship to the "camera" selection for the system configuration. Similarly, in Figure 5B of the applicant's disclosure, in the overlying window with the system configuration characteristics listed, several of the characteristics have nothing to do with the "printer" selection and one of the characteristics has nothing to do with the "camera" selection, and thus the characteristics of the system listed in the overlying window represent characteristics of the particular capabilities of the combination of at least two system elements of the system configuration.

Appln. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

Contrast the applicant's disclosure with the disclosure in Figures 3A and 3B of Henson, wherein each "option recommendation 75" is directed only to the particular component with which the "recommendation" is associated. Again it is noted (as was noted in applicant's previous responses) that the "recommendations" of Henson do not appear to change depending upon the particular selection made for the component, as the "recommendation" is just that: a general statement of why increasing the quantity of one characteristic is better. It is left up to the user of the purchaser to decide what effect any one selection has on the abilities of the overall system configuration.

Turning to the section of the specification of the applicant's application that is referenced in the "Response" portion of the Office Action, it is again noted that patentability is not based upon distinctions between the applicant's *disclosure* and the prior art, but upon the distinctions between the applicant's *claims* and the prior art. However, this portion of the arguments in the Office Action will be addressed in hopes of further clarifying for the Patent Office the distinction between the applicants' *claims* and the prior art. The applicant's disclosure states at page 5, lines 13 through 24 that (emphasis added):

Referring now to FIGS. 5A and 5B, alternative embodiments of displays of the browsing interface of the present invention is shown. Referring specifically to FIG. 5A, a lower end model of a printer and a lower end model of a digital camera have been selected in the purchase of a build-to-order computer system. Based upon the user's selections of a lower end model of a printer and a lower end model of a digital camera, a window presenting information regarding the functionality of the system is presented. In FIG. 5B, a higher end model of a printer and a higher end model of a digital camera has been selected by a user. The browsing interface of the present invention may provide a description of the function capable of being implemented with the higher end selections. The content presented by the browsing interface of the present invention may inform the user regarding the advantages of a particular system configuration in order to allow the user to acquire a system that meets his or her needs.

Appln. No. 09/876,577

Amendment dated March 28, 2007

Reply to Office Action mailed November 28, 2006

As has been noted, the applicant's disclosure, including here in the specification, supports a clear distinction between the characteristics of a particular type of component and the capabilities of the combination of at least two system elements of a particular system configuration. Note Figure 4 of the applicant's disclosure and the supporting description in the paragraph bridging pages 4 and 5 of the applicant's specification, which discloses the characteristics or advantages of a particular component selection (in this case, the processor) rather than any combination of system elements in a particular combination. The applicant's disclosure thus clearly recognizes a distinction between the characteristics of different selections for a particular component, and the capabilities of a combination of selected system devices.

The "Response to Arguments" also includes the contention that:

Further, it is also very clear from Figs. 3A and 3B that the description of a function provided, such as for printers and scanners [capable to print the kid's artwork or output professional quality documents and for scanners to be able to turn hardcopies of photographs and graphics into digital files, etc] would be dependent on both the selection of the processor, that is Dell Dimension XPS R Minitower as well as the printer or scanner and their particular capabilities of the combination of said two elements in said configuration systems.

However, assuming for the purposes of argument only that it is correct that the functions of the system would depend upon the "selection of the processor", Figures 3A and 3B of the Henson patent do not disclose that the customer has any ability to "select" the processor of the system under configuration. Further, these Figures of the Henson patent do not disclose that the "selection" of the processor (assuming for the purpose of argument only that there is such an option) changes any of the characteristics set forth in the generic "merchandising messaging 79" statement of the webpage or the "option recommendations 75" for the components, for that matter. While it is conceded that the system needs a processor to function, it is submitted that it is not at all apparent from the Henson patent that any

Appln. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

"selection" of a processor affects any of the "capabilities" allegedly set forth on the configuration webpage, particularly for the printer or scanner discussed in the Office Action.

It is still further stated in the "Response to Arguments" that:

Further, it is to be noted as disclosed in the applicant's disclosure, see Figs. 5A and 5B and paragraph 0018 of the PS-PUB 2002/0188519 A1 of the applicant's application that the description of the functions provided to the user who is configuring the selection include a description of a function capable of being implemented by each component...

The specification of the present application states at the referenced portion that:

[0018] The browsing interface of the present invention may receive a system configuration selection based on a combination of system elements selected from the list of configuration choices 230. It is understood that a system configuration selection based on a combination of system elements may include but is not limited to a selection of a single component or a group of components without departing from the scope and spirit of the present invention. The relational database of the present invention may analyze the system configuration selection and provide a description of a function capable of being implemented with the system configuration selection 240. The information presented may include a description of a function capable of being implemented by each component.

Again, it appears that the Patent Office would rather compare the applicant's *specification* to the prior art rather than compare the requirements of the applicant's claims to the prior art, which are what is really at issue here. In any event, while the applicant's specification may discuss the function of a single component, the claims do not and the arguments here will be directed to the requirements of the claims. Also, as noted above, Figure 4 and the accompanying text of the present application discusses the possibility of a pop-up window that "include[s] information regarding [a] particular component", while at Figure 5 and the accompanying text, the function of the overall system configuration is discussed. Thus, clearly, the applicant's disclosure makes a distinction between displaying "information regarding a component" and "the

Appln. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

advantages of a particular system configuration", without confusing the two options.

The "Response" continues (emphasis added):

...and that is exactly what is shown in Dell's Figures 3A and 3B, wherein the description of functions capable of being implemented by each component, such as Minitower, Monitor, Printers, and Scanners is provided. Further the functions of the Monitor, printer or scanner as described would be dependent on the particular capabilities of each of these system elements combined with the capability of the Dell processor.

The last statement in this portion of the "Response to Arguments" is believed to be misdirected, as there does not appear to be any statement in the "option recommendations 75" or the "merchandising messaging 79" that supports this contention. More specifically, no change in the particular monitor selected on the Henson webpage affects the "option recommendation" of any other component, no change in the printer selected changes any of the option recommendations of any other component, and no change in the scanner selected changes any of the option recommendations of any other component. The Examiner is requested to provide one example of a selection of a printer and the "dependent" change in any statement of function on the Henson webpage.

It is further stated that:

This interpretation is further exemplified when Dell provides the description that a particular SELECTION OF SYSTEM ELEMENT is not valid such as in the case of selecting a Video card that it may not be compatible with a windows NT operating system. The system both in Henson and in the applicant's disclosure, see Figs. 5A and 5B and paragraph 0018 of the PG-PUB 2002/0188519 A1 of the applicant's application works on the same basis that is a software analyzes the system configuration selection and provide a description of a function capable of being implemented by two system elements together.

However, simply because the webpage depicted in Henson alerts the customer to a potential conflict between a component and operating system software does not equate to a "description of a function capable of being

Appln. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

implemented with the combination of at least two system elements". To the contrary, this alert to a potential conflict between component and software is a statement of *dysfunction*, not of any *function*. The failure of the system to function with a particular configuration is not a "description of a function" as required by claim 1. While this software conflict information might be helpful to a customer, it certainly does not help a customer compare the relative advantages of the functions of system configurations with different combinations of system elements.

The "Response" further states with respect to Claim 2:

The examiner respectfully disagrees. See Fig. 5 which clearly teaches that "a selection will require changes to other configuration choices" which clearly implies that there can be several configuration choices with different system elements/components and thus by changing a particular selection the system detects first if that particular element is compatible or not and if compatible if provides the description of the function of that system and further by pressing the 'question Mark' icon more description information is provided on that selected system element.

As noted above, the alert to a potential software/component conflict does not provide the customer with "a description of *a function capable of being implemented with the combination* of at least two system elements of said system configuration selection" as required by claim 1, and merely warns the customer of a dysfunctional configuration. Merely because this warning will be shown for some conflicting configurations, and not for others, does not mean that the Henson system provides any different component information when different combinations are selected. The "Response" further contends that:

Secondly, the argument that the descriptions associated with each of the component are so general in nature that there is no change needed in these descriptions based upon the change in the option selected, that is the description are not specific to any one option selected for a component is not relevant because the claim 2 does not recite any limitation which specifies that the descriptions cannot be general. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the descriptions associated with each of the component are so general in nature

Appln. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

that there is no change needed in these descriptions based upon the change in the option selected, that is the description are not specific to any one option selected for a component) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The fact is, in the Henson system, no matter what choices the customer makes for the components to be used, the general statements on the webpage with respect to the function of the system will not change. Thus, these statements do not represent "a description of a function capable of being implemented with the combination of at least two system elements of said system configuration selection", with "said description of a function being dependent upon particular capabilities of the combination of said at least two system elements included in said system configuration selection", as one of ordinary skill in the art recognizes that no matter what combination is selected, the statements remain the same. The possibility that the customer may be warned about a software conflict is not "a description of a *function capable of being implemented* with the combination of at least two system elements of said system configuration selection", and does not bring the Henson system within the meaning of claim 1.

Turning now to the rejections themselves, the portion of the Henson patent at col. 6, lines 18 through 43 that is referenced in the rejection of the Office Action states (emphasis added):

Turning now to FIG. 3 (3A, 3B, and 3C), from a system configuration options screen 70, a customer of the online store 10 can build a customer configured machine by selecting from options listed on the configuration screen 70. The pricing option module 28 includes an update price function. The update price function causes the price displayed on the configuration screen to reflect any changes made to the system options. Selection of the update price function can be accomplished by clicking on an "UPDATE PRICE" icon 72 on the configuration screen. Upon obtaining a desired configuration, a customer could then select the "ADD TO CART" icon 74 to add the configured system to the shopping cart 20 and continue shopping, as desired.

The present online store application and system provide an on-line store application which includes configuration, pricing, validation, shipment

Appl. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

delay indication, and merchandising modules. The validation module provides validation of some form with respect to the customer built configuration. The shipment delay indicator provides the customer with any lead time warnings or shipment delays which would occur as a result of the selection of specific options. In addition, the merchandising module provides messaging, alternatively referred to herein as merchandising information or messaging, of options recommended to be selected in a particular configuration, including, for example, which options may be better than others.

In this portion of the Henson patent, the only discussion that is relevant to the requirements of claim 1 occurs at the end of the section, and merely indicates that "merchandising information" may be included that is directed to individual options—such as which options are recommended, and which options may be better than others. It is submitted that one of ordinary skill in the art recognizes that this discussion in Henson indicates that the Henson system simply provides recommendations regarding choices between individual options for a component, and may point out why one option for an individual component is better than another option for the individual component. It is submitted that this portion of the Henson patent does not anticipate the requirement of claim 1 that "providing a description of a function capable of being implemented with the combination of at least two system elements of said system configuration selection". In fact, it is submitted that, if anything, the Henson patent at this portion tends to lead one of ordinary skill in the art away from the requirements of claim 1, as it emphasizes describing the advantages/disadvantages of a particular option for an individual component, rather than any advantages or benefits of the combination of two system elements.

In the rejection of the Office Action that addresses the Henson system, it is stated that (emphasis added):

Note: In Figs. 3 A, 3 B and 3C Henson provides a list of configuration choices in the form of displaying various choices for selecting a Dell XPS R Minitower, Monitor, memory, hard drive, monitor, Printers, Scanners, etc., thereby prompting an user to make selections to configure and order a build-

Appl. No. 09/876,577

Amendment dated March 28, 2007

Reply to Office Action mailed November 28, 2006

to-order computerized system. While presenting the choices, Henson also provides description of functions of the system elements.

As noted above, the Henson patent does describe a system in which the functions of various individual system elements are described, but, again, this does not provide the user with any indication of any "description of a function capable of being implemented with the combination of at least two system elements of said system configuration selection", as required by claim 1. Turning to the showing in Figures 3A and 3B of Henson, it is clear to one of ordinary skill in the art that the screen of the system lists a number of components that make up the system configuration, and each type of component in the list has a window associated with it that includes a drop down menu list of different options. Significantly, some of the components in the list have associated with it a short blurb that is not specific to any of the options that are listed in the window for the component—only to the component. See, for example, the blurb associated with "Hard Drive", which generally states "[a] larger hard drive provides more storage for your operating system, Internet files, applications, graphics and scanned images!" However, this does not provide any "description of a function capable of being implemented with the combination of at least two system elements", as it is clearly limited to the functionality provided by that component of the system by itself. Another example is the blurb associated with "Printer", which states "[d]on't forget your printer! Whether you need to print your kid's artwork or output professional quality documents, Dell has the perfect printer to meet your needs." Again, this blurb simply points out general information about printers, but does not provide any "description of a function capable of being implemented with the combination of at least two system elements", merely stating what the addition of one component—a printer—to the system can add for functionality. In both of these example, as well as the other blurbs associated with the other components listed in the screen in Figures 3A and 3B, the blurbs are static and do not change as the combination of

Appln. No. 09/876,577

Amendment dated March 28, 2007

Reply to Office Action mailed November 28, 2006

components selected changes. Clearly, if the blurbs in the listing of Henson were "description of a function capable of being implemented with the combination of at least two system elements", they would be changeable as the selected options for the different components were changed, and that does not occur here. This is also noted in connection with claim 2, which requires "providing an updated description of a function capable of being implemented with said updated system configuration selection", as there does not appear to be any change in these blurbs as the configuration is changed.

The text of the rejection continues (emphasis added):

Henson teaches configuring a computer system made of two or more system elements, see Figs. 3A and 3B which show configuring a computer system made of several system elements, such as Dell SPS R Minitower, Monitor, Printers, and Scanners and also provides a description of function capable of being implemented with the combination of at least two systems, that is providing function of Dell Minitower as to deliver tremendous speed to high end applications, for Printers for being capable to print the kid's artwork or output professional quality documents and for scanners to be able to turn hardcopies of photographs and graphics into digital files, etc. This is in line with the applicant's invention as disclosed in Fig. 5 A and page 5, lines 13-18 which show selecting two system elements as a printer and a camera and displaying the description of function of each element, that the capabilities of the printer and camera separately for the combined system including printer and camera. Also, see FIG. 5 and col. 9, lines 9-25)

It appears that this portion of the rejection is referring to the generalized statement in the heading of the screen in Figure 3A that "Built with high performance and reliability in mind, the Dell Dimension XPS R series use the latest in technology to deliver the tremendous speed your high-end applications are craving". However, this statement, which basically amounts to advertising puffery that appears to apply to any and configurations of the system, does not "provid[e] a description of a function capable of being implemented with the combination of at least two system elements" that is dependent upon any combination of system elements that is

Appln. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

received, and there is nothing in the Henson patent that suggests that this generalized puffery is ever changed based upon the configuration selected.

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Henson, Tuzhilin, and Roberts set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1, 9, 17 and 31. Further, the claims that depend from claims 1, 9, 17 and 31, also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

With respect to claim 2, which requires "receiving an updated system configuration selection" and "providing an updated description of a function capable of being implemented with said updated system configuration selection", the assertion in the rejection of the Office Action that the "price and functions" of the system are "updated" when the user clicks on the "UPDATE PRICE" button is not supported by the disclosure of Henson. While the price may be updated (which is not a "description of a function") upon clicking on this button, there is nothing to indicate that any of the functional descriptions of the individual components changes in any way. While it is asserted that "any changes in the options would inherently show descriptions corresponding to the changed options", it is submitted that 1) there is no evidence in the Henson patent that these descriptions of the components change with a selection of a different component option, and 2) the "descriptions" associated with each of the components are so general in nature that there is no change needed in these descriptions based upon the change in the option selected—the "descriptions" are not specific to any one option selected for a component. It appears that the statements in the rejection are based upon speculation as to what the Henson system *might* do when the "UPDATE PRICE" button is clicked, as there is no disclosure in the Henson patent which would suggest that the blurbs associated with each of the components, or even with the "Dell Dimension XPS R" system in

Appln. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

general, are "updated" to provide "an updated description of a function capable of being implemented with said updated system configuration selection". In fact, it is submitted that the figures and discussion in the Henson patent are more likely to suggest to one of ordinary skill in the art that the blurbs are *not* updated when the price is updated.

Claim 4 requires "wherein at least one of said available system elements in said list of configuration choices being represented by an icon", and the rejection of the Office Action alleges that this feature of the claimed invention is disclosed in Figure 5 and in col. 9, lines 9 through 25, which state:

With reference again to the configurator, the view module 30 includes an "all option" configurator view. That is, an ability to change from a standard view 70 (as shown in FIG. 3) to an "all option" view 90 (as shown in FIG. 5) is provided. The standard view of the online configurator is where system options 77 are presented via "drop-down" selection boxes and only the currently selected option is displayed. The standard view is preferably the default display, i.e., displayed without a shopper action. However, selection of the standard view may be accomplished via selection of the standard view selection button 96 (FIG. 3) The "all option" configurator view is where all system selection options are shown at the same time. In the later view, selections are made via use of "radio buttons" 92. Activation of the "all option" configurator view is made by selection of the appropriate view selection button 94 (FIG. 5).

However, contrary to the contention in the rejection that this portion of Henson shows the claimed "icon", it is submitted that the discussion here only mentions associating a radio button with each of the options. Since the radio button is the same for all of the options listed, with no differentiation between them (see Figure 5), it is submitted that this portion of Henson does would not lead one of ordinary skill in the art to the requirement of claim 4 of "at least one of said available system elements in said list of configuration choices being *represented by an icon*".

Withdrawal of the §102(e) and §103(a) rejections of claims 1, 2, 4 through 24, 26, 28 and 30 through 34 is therefore respectfully requested.

Appln. No. 09/876,577
Amendment dated March 28, 2007
Reply to Office Action mailed November 28, 2006

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

WOODS, FULLER, SHULTZ & SMITH P.C.



Date:

MARCH 28, 2007

Jeffrey A. Proehl (Reg. No. 35,987)
Customer No. 40,158
P.O. Box 5027
Sioux Falls, SD 57117-5027
(605)336-3890 FAX (605)339-3357

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☒ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☒ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.